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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,416	02/22/2002	Oliver Yoa-Pu Hu	39297-174170	8467

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EXAMINER

KIM, VICKIE Y

ART UNIT PAPER NUMBER

1614

DATE MAILED: 09/05/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/079,416

Applicant(s)

YOA-PU HU ET AL.

Examiner

Vickie Kim

Art Unit

1614

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1, 2 and 17-32.

Claim(s) withdrawn from consideration: 10-16.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Vickie Kim  
Patent examiner

Continuation of 2. NOTE: As discussed in the interview that is initiated by applicant and performed on August 29, 2003, the claimed subject matter is not patentably distinct over the prior art of the record. Firstly of all, the claims are drawn to a compound(e.g. alpha naphthoflavone) and a composition comprising the said compound where the compound is well known for decades. Although, applicant's invention recites the activities(e.g. dermal cytochrome P450 1A inhibitory activity) incorporated into the claims, the claimed activity does not have patentable weight because the limitation in the preamble does not change the structure of the claimed subject matter that is a compound such as alpha naphthoflavone or a composition comprising the said compound. As mentioned in the previous office action, US'157 or WO'769 teaches the claimed subject matter(see paper no. 9). For instance, US'157 clearly teaches that alpha naphthoflavone is well known inhibitor of human P4501A, see col. 8, lines 62-66 and col. 29, lines 33-36 in addition to the claim 8. Furthermore, the amendment recently filed include the changes that is affecting the scope of the invention(e.g. deleting the critical element such as alpha.naphthoflavone from the claims, see claim 2 of most recent amendment ). Because these changes are filed after the prosecution closed(after final), the amendment will not be entered because it requires new search and consideration. And entering the amendment does not place the application under allowable condition because the claims(newly amended) are still not patentably distinct over the prior art of the record due to the reasons above. In response to the applicants argument made in the remarks(see paper no.10), the argument is not persuasive because US'157 clearly teaches that alpha naphthoflavone is an inhibitor of human P4501A, see column 8, lines 62-66 and column 29, lines 33-36 and claim 8. As col. 29, lines 33-34, US'157 clearly states that alpha naphthoflavone( NF) is known to be a strong competitive inhibitor of human P4501A2. As the evidentiary document, MCManus et al that is cited in US'157 patent at col. 29, line 35 was provided to the applicant to prove this examiner's allegation(e.g. alpha naphthoflavone as an inhibitor of Cytochrome P450 1A ), see abstract. Most importantly, since the P4501A inhibitory activity recited in the preamble, the claimed subject matter (e.g. the compound such as alpha-naphthoflavone or the composition) thereof is not patentably distinct due to the reasons of the record(paper no. 6 & 9).